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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,827	05/15/2001	Heng Chu	RSW920010061US1	9663

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EXAMINER

RHODE JR, ROBERT E

ART UNIT PAPER NUMBER

3625

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/855,827

Applicant(s)

CHU ET AL.

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

In Claims 1 - 10, the claimed invention is directed to non-statutory subject matter. The claim is directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. See *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974). For example in claim 1, the invention in the body of the claim does not recite the use of nor incorporate any technology in carrying out the recited method steps and therefore is not statutory. If the invention in the body of the claim is not tied to the technological arts, environment or machine, the claim is not statutory. See *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) [Unpublished] and note MPEP 2106 IV 2(b). While *Bowman* is not precedential, it has been cited for its analysis.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1, 5, 9, 11, 12, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller (US 2001/0054008 A1) in view of Bouve (US 6,415,291 B2).**

Regarding claim 1 and related claims 11 and 14, the combination of Miller and Bouve teach a method and system of optimizing a shopping list process, comprising steps of: where Miller teaches obtaining a shopping list comprising one or more items (see at least Abstract and Figure 8). In addition and regarding claim 5 and related claims 12 and 15, Miller teaches a method, further comprising steps of traveling to each successive merchant on the computed shopping path, purchasing zero or more items from the shopping list at each merchant; and remembering which items have been purchased (Abstract and Figure 2). Regarding claim 9, Miller teaches a method, wherein the merchants are dynamically contacted to determine availability of the items on the shopping list (Abstract and Figure 2).

However, Miller does not specifically disclose and teach obtaining one or more factors which a user wishes to use in optimizing a shopping path for the items on the shopping

list, determining one or more merchants and locations thereof where the items may be purchased; and computing the shopping path to visit selected ones of the merchants, wherein the merchants are selected according to the one or more obtained factors.

On the other hand, Bouve teaches obtaining one or more factors which a user wishes to use in optimizing a shopping path for the items on the shopping list (see at least Abstract, Col 2, lines 49 - 67 and Figure 2), determining one or more merchants and locations thereof where the items may be purchased (see at least Figure 2); and computing the shopping path to visit selected ones of the merchants, wherein the merchants are selected according to the one or more obtained factors (see at least Abstract and Figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Miller with the method and system of Bouve to have enabled a method and system of optimizing a shopping list process, comprising steps of: where Miller teaches obtaining a shopping list comprising one or more items; obtaining one or more factors which a user wishes to use in optimizing a shopping path for the items on the shopping list, determining one or more merchants and locations thereof where the items may be purchased; and computing the shopping path to visit selected ones of the merchants, wherein the merchants are selected according to the one or more obtained factors – in order to ease the shoppers burden both from remembering the list as well as having to figure out a route to these merchants, which is

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usually less than optimum. As a result and with these capabilities, the shopper's satisfaction will be greatly increased, which increase the probability that they will return to use the service again for other shopping trips as well as recommend the service to others.

**Claims 2 – 4, 6 – 8, 10, 13, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Miller and Bouve as applied to claims 1, 11 and 14 above, and further in view of Ogasawara (US 6,386,450 B1).**

The combination of Miller and Bouve substantially discloses and teaches the applicant's invention.

However, the combination does not specifically disclose and teach a method, wherein one of the obtained factors is to optimize a path length for the shopping path, purchase cost, and cost of items as a shopping list which excludes items; and includes a shopping path begins from an identified starting location and terminates at an identified ending location, which may be identical to the starting location as well as dynamically contacting merchants to determine availability of the items on the list; and comprising the step of computing a summary after visiting the selected merchants, wherein the summary comprises information pertaining to one or more of which merchants were visited; the remembered items which were purchased; a cost of the remembered items which were purchased; a count of merchants visited; a cost savings of the remembered items which were purchased.

On the other hand and regarding claim 2, Ogasawara teaches a method, wherein one of the obtained factors is to optimize a path length for the shopping path (see at least Col 2, lines 61 – 67 and Col 3, lines 57 – 60).

Regarding claim 3 and 4, the recitation that “ wherein one of the obtained factors is to optimize a purchase cost for the items on the shopping list” and (4) “wherein one of the obtained factors is to optimize a number of merchants on the shopping path”, such recitation(s) are given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other “optimization” already disclosed by Ogasawara. Moreover, optimization techniques of various functions to provide specific results are old and well known before the time of the applicant’s invention and known to one of ordinary skill in the art (see US 6,411,922 B1). Therefore, it would have been obvious to incorporate optimization techniques into the method and system of Ogasawara to include purchase cost and number of merchants on the shopping path in order to ease the list making and resultant mental stress for the customer in remembering everything. In this manner, the customer satisfaction will be increased and thereby increasing the probability that the customer will continue to use the offered service capability.

Regarding claim 6 and related claims 13 and 16, Ogasawara teaches a method, further comprising steps of creating a revised shopping list which excludes the remembered

items; and determining whether items expected at a particular one of the merchants were available for purchase, and if not, recomputing the shopping path after adding the items which were unavailable to the revised shopping list (Col 2, lines 61 – 67 and Figures 4, 5A and B and 9). Please note that Ogasawara does not refer specifically to merchants, rather to a merchant and defining an optimum shopping path for the shopper in the merchant's store. In this regard, it would have been obvious to add the capability to expand the geographical area as with Bouve to include other merchants. In this manner, the customer would be pleased and use the service capability in addition to include these other merchants. In this manner, the customer will likely recommend the service to others.

Regarding claim 7, Ogasawara teaches a method, wherein the shopping path begins from an identified starting location and terminates at an identified ending location, which may be identical to the starting location (Col 3, lines 57 – 60).

Regarding claim 10, Ogasawara teaches a method, further comprising the step of computing a summary after visiting the selected merchants, wherein the summary comprises information pertaining to one or more of which merchants were visited; the remembered items which were purchased; a cost of the remembered items which were purchased; a count of merchants visited; a cost savings of the remembered items which were purchased (Col 16, lines 20 – 22).



It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of Miller and Bouve with the method and system of Ogasawara to have enabled, wherein one of the obtained factors is to optimize a path length for the shopping path, purchase cost, and cost of items as a shopping list which excludes items; and includes a shopping path begins from an identified starting location and terminates at an identified ending location, which may be identical to the starting location as well as dynamically contacting merchants to determine availability of the items on the list; and comprising the step of computing a summary after visiting the selected merchants, wherein the summary comprises information pertaining to one or more of which merchants were visited; the remembered items which were purchased; a cost of the remembered items which were purchased; a count of merchants visited; a cost savings of the remembered items which were purchased – in order to include the capability of remembering as well as updating a shopping list based on results from the current trip. In that regard, the shopper's burden for remembering everything, which will ease their already overburdened minds and thereby increase their satisfaction. With this increased satisfaction, the probability is increased that their loyalty and continued use of this service for future shopping will also be increased.

### ***Conclusion***

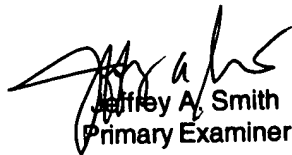
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 703.308.3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER



Jeffrey A. Smith  
Primary Examiner